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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,241	11/09/2001	Heidi Munnelly	1217.013USU/KPG 1141	9269

7590

12/02/2003

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/040,241

Applicant(s)

MUNNELLY ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 9-8-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-14, 22-34, 36-39 and 46-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14, 22-34, 36-39 and 46-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 10-14, 22-34, 36-39, and 46-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All independent claims now present in this application limit the polymeric binder (A) to 20-80% by weight, based on the infrared sensitive composition, but at 80% by weight the polymeric binder is beyond the limits allowed if all the other components are at their minimum, i.e. 25% (B)(1) and 0.05% (2)(a) and 2% (2)(b) and 1%(2)(c). Because of this, the limits of the amounts set forth in claims 1-8, 10-14, 22-34, 36-39, and 46-60 are confusing. Do any of the B components overlap the (A) binder? It is unclear that this is intended by the original disclosure. Thus, what is meant by this overlap of percentages is unclear. This issue was not present until the claim language was amended.

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5. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. ---Q--- in claim 51 represents an "optional five or six membered carbocyclic ring." This does not make sense in view of ---Q--- appearing to be only some members of a ring and not an entire ring unto itself. In claim 24, ---Q--- is referenced as "a optional bridge completing a five or six membered carbocyclic ring" which is what the specification has been amended to. This language in claim 54 is confusing in view of examples on pages 21-25 showing only bridges for ---Q--- and not complete rings.

6. Claim 48 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to show support for the addition of this genus, i.e. "the free radical polymerizable system includes a monomer, oligomer, or prepolymer derived from acrylic or methacrylic acid." Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitation in the application as filed.

7. Claim 53 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitation "and a combination thereof" in regard to the list of compounds capable of producing radicals in the application as filed.

8. Claims 1-8, 10-14, and 48-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weed et al (EP 0 889 363 A1). With respect to instant claims 1-8, 10-14, and 48-55, Weed et al teach the use of infrared absorbing dyes, halogenated HABI compounds that generate free radicals and n-phenylglycine which fits the instant (c) at least one carboxylic acid compound to polymerize compositions with ethylenically unsaturated compounds and binders inclusive of binders without acid groups. There is no one working example using these components but each variation is clearly taught as a whole of the compositions disclosed and the compositions are also taught to be used in flexographic printing plates. Thus, with respect to instant claims 1-8, 10-14, and 48-55, the use of non acidic binders in the compositions of Weed et al with applications wherein development is effected using solvent development with an organic liquid developer or semi aqueous development with a liquid mixture containing water and organic solvents, it is not required that the binder of Weed et al have acid containing functionality such as carboxylic acid functionality. In these cases, all of the comonomers for the binder(s) can be non-acid containing comonomers. In Weed et al, see particularly the paragraph bridging pages 6-7 with respect to the binder being non acidic, and for other points see the Abstract, page 3, lines 48-page 4, lines 5, page 5, Chain Transfer Agent and N-phenylglycine as one of the preferred chain transfer agents, page 6, Binder Polymers, page 9, Preferred Ranges, page 10, lines 36-44, and line 55 to page 12, line 4, Example 31 with attention to use as flexographic printing plate precursor and use of cover layer.

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9. Applicant's arguments filed September 8, 2003 have been fully considered but they are not persuasive. Applicants admit that Weed does disclose where acid functionality in the binder is not required by Weed that Weed states that an organic liquid developer or semiaqueous development with a liquid mixture containing water and an organic solvent is the option. Then applicants go on to say Weed does not show such. The examiner notes that Weed teaches such and that is enough in this instance. Applicants argue about "suitable aqueous developer comprising about 83.58% water" in their applications but the instant claims are not so limited. The instant claims encompass any aqueous developer even those of Weed that are semiaqueous. The rejection stands for reasons of record. Dispersibility in a "suitable aqueous developer" is any developer that is suitable for the system set forth. The system is taught by Weed as is the use of an aqueous developer. The breadth of developer claimed encompasses any aqueous developer with any added organic solvent not just those disclosed by applicant.

10. Rejections based on Hauck are removed in view of the instant amendments made by applicants along with comments set forth by applicants.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cynthia Hamilton whose telephone number is (703) 308-3626. As of December 12, 2003, this telephone number will be 571-272-1331. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff can be reached on 703-308-2464. As of December 12, 2003 this phone number will be 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 0661.*



**CYNTHIA HAMILTON  
PRIMARY EXAMINER**

Primary Examiner Cynthia Hamilton

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December 1, 2003